No. 89-1523

In the

Supreme Court of the United States

October Term, 1989

COX-UPHOFF CORPORATION and
COX-UPHOFF INTERNATIONAL,
Petitioners,

v.

MENTOR CORPORATION;
LINDA RADOVAN WILLIAMSON,
as executrix of the Estate of CHEDOMIR RADOVAN;
HILTON BECKER, M.D.; and
BEVERLY ANNE BECKER;
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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COUNTERSTATEMENT OF QUESTION PRESENTED FOR REVIEW

Whether this Court should review the decision of the United Stated Court of Appeals for the Federal Circuit holding that the defendants' motion for amended findings of fact and conclusions of law and for a new trial was untimely because it was served more than ten days after entry of judgment, when the Federal Circuit's ruling is not in conflict with any decision of this Court or any other court of appeals and the issue lacks importance to any party other than petitioner?

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No. 89-1523

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COX-UPHOFF INTERNATIONAL,
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BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents Mentor Corporation, Linda Radovan Williamson, as executrix of the estate of Chedomir Radovan, Hilton Becker, M.D., and Beverly Anne Becker (collectively "Mentor")[1] oppose the Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit submitted by petitioners Cox-Uphoff Corporation and Cox-Uphoff International[2] (collectively "Cox-Uphoff"). Final judgment was entered on February 28, 1989, when the district court set aside the jury verdict and granted Cox-Uphoff's motion for judgment notwithstanding the verdict. On March 17, 1989, more than ten days after the entry of judgment, Cox-Uphoff moved for amended findings of fact, conclusions of law, and judgment, in addition to requesting that the district court rule on Cox-Uphoff's earlier motion for a new trial. Having failed to successfully argue to the Federal Circuit (on three different occasions) that its March 17, 1989 motion was timely, Cox-Uphoff seeks a change in the law regarding the well-established procedural rule that a motion to amend the judgment and a request for a new trial must be served within ten days after entry of judgment. *See* Fed. R. Civ. P. 50, 52, 59.

Cox-Uphoff's petition is fatally flawed because it fails to present any special or important reasons warranting grant of the writ. Nor has Cox-Uphoff identified an actual conflict among the courts of appeals or a decision of this Court that conflicts with the Federal Circuit's decisions regarding the timeliness of Cox-Uphoff's post-judgment motion. Cox-Uphoff also has failed to identify any issue of jurisprudential importance that this Court needs to correct or to clarify. Accordingly, Cox-Uphoff's petition should be denied.

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[1] Pursuant to Rule 29.1 of the Rules of the Supreme Court of the United States, Mentor states as follows: the names of the real parties in interest are respondents. Respondent Mentor Corporation has no parent company and has no subsidiaries, with the exception of one wholly owned subsidiary.

[2] Cox-Uphoff International never answered the complaint in this action, and Mentor obtained a default judgment against it. (*See* Petitioners' Appendix at A-12 n.*.) Accordingly, Cox-Uphoff International no longer has any involvement with this lawsuit and is not properly named as a petitioner.

OPINIONS BELOW

Mentor is satisfied with Cox-Uphoff's presentation of the opinions below.

STATEMENT OF JURISDICTION

Mentor is satisfied with Cox-Uphoff's statement of the jurisdiction of this Court.

STATUTORY PROVISIONS INVOLVED

Cox-Uphoff's petition concerns Rules 50, 52, and 59 of the Federal Rules of Civil Procedure, which provide in relevant part:

> **Rule 50. Motion for a Directed Verdict and for Judgment Notwithstanding the Verdict**
>
> *
>
> **(b) Motion for Judgment Notwithstanding the Verdict . . . .** Not later than 10 days after entry of judgment, a party who has moved for a directed verdict may move to have the verdict and any judgment entered thereon set aside and to have judgment entered in accordance with the party's motion for a directed verdict . . . . A motion for a new trial may be joined with this motion, or a new trial may be prayed for in the alternative . . . .
>
> * *
>
> **Rule 52. Findings by the Court**
>
> *
>
> **(b) Amendment.** Upon motion of a party made not later than 10 days after entry of judgment the court may amend its findings or make additional findings and may amend the judgment accordingly . . . .
>
> * *

Rule 59. New Trials; Amendment of Judgments

*

(b) Time for Motion. A motion for new trial shall be served not later than 10 days after the entry of the judgment.

* *

COUNTERSTATEMENT OF THE CASE

Introduction. This case involves patent law, although the sole issue presented in Cox-Uphoff's petition is one of civil procedure. Mentor [3] commenced this litigation against Cox-Uphoff in August 1987, claiming that Cox-Uphoff infringed United States Letters Patent No. 4,217,889 and United States Letters Patent No. 4,643,733.

The only issue presented in Cox-Uphoff's petition is governed by the rules of civil procedure. The question presented is whether the Cox-Uphoff timely filed its March 17, 1989 motion for amended findings of fact and conclusions of law and for a new trial, even though Cox-Uphoff, in contravention of the rules of procedure, filed the motion more than ten days after judgment was entered.

The jury's verdict and opinions below. After trial to the jury on the issue of Cox-Uphoff's liability for infringement of Mentor's patents, the jury returned verdicts in favor of Mentor, finding that both of Mentor's patents were valid and that Cox-Uphoff infringed them. On October 3, 1988, the United States District Court for the Central District of California entered judgments on the jury's verdicts in the total amount of $690,000 plus costs. (Petitioners' Appendix at A-4, A-5.)

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[3] As a result of a motion by Cox-Uphoff to dismiss the complaint for failure to join indispensable parties, Mentor added Linda Radovan Williamson, Dr. Hilton Becker, and Beverly Anne Becker as named plaintiffs. Mentor is the licensee of the Becker patent in issue, not the assignee as claimed by Cox-Uphoff.

On October 5, 1988, Cox-Uphoff moved for judgment notwithstanding the verdict and, in the alternative, for a new trial. (Petitioners' Appendix at A-58.) Thereafter, the district court granted Cox-Uphoff's motion for judgment notwithstanding the verdict. (Petitioners' Appendix at A-6.) On February 28, 1989, the district court issued its Findings of Fact and Conclusions of Law and its Judgment in favor of Cox-Uphoff, holding that Cox-Uphoff did not infringe one patent and that the other patent was invalid. The district court did not rule on Cox-Uphoff's motion for a new trial. (Petitioners' Appendix at A-12.)

Thirteen days after the district court entered judgment notwithstanding the verdict, on March 17, 1989, Cox-Uphoff moved the district court to amend its findings of fact and conclusions of law. (Petitioners' Appendix at A-68.) In addition, Cox-Uphoff moved for a new trial, requesting the conditional grant of a new trial. (Petitoners' Appendix at A-68.)

Mentor appealed the district court's judgment notwithstanding the verdict. Cox-Uphoff, in response, moved the United States Court of Appeals for the Federal Circuit for dismissal of the appeal pursuant to Rule 4(a) of the Federal Rules of Appellate Procedure. The Federal Circuit denied Cox-Uphoff's motion to dismiss, ruling that Cox-Uphoff's post-judgment motion of March 17, 1989 was not timely filed, because Cox-Uphoff filed it more than ten days after the district court entered final judgment on February 28, 1989. (Respondents' Appendix at A-1.)[4]

Thereafter, on April 24, 1989, the district court conditionally granted the Cox-Uphoff's motion for a new trial. (Petitioners' Appendix at A-50.) The district court

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[4] As a result of its determination that Cox-Uphoff's motion to dismiss was frivolous, the Federal Circuit awarded Mentor its attorneys' fees. (Respondents' Appendix at A-1.) On May 23, 1989, the Federal Circuit denied Cox-Uphoff's motion for reconsideration of its April 3, 1989 order denying Cox-Uphoff's motion to dismiss and again awarded Mentor its attorneys' fees for having to respond to Cox-Uphoff's frivolous motion. (Respondents' Appendix at A-3.)

ruled, assuming it had jurisdicion to do so, that if the Federal Circuit reversed the judgment notwithstanding the verdict, then Cox-Uphoff was entitled to a new trial on the grounds that the jury's verdict was contrary to the substantial weight of the evidence and the damage award was excessive. (Petitioners' Appendix at A-50.)

The Federal Circuit, on November 9, 1989, reversed *per curiam* the judgment notwithstanding the verdict entered by the district court. (Petitioners' Appendix at A-1, A-52.) The appeals court vacated the district court's February 28, 1989 findings and conclusions, in addition to the district court's conditional order of a new trial. (Petitioners' Appendix at A-1, A-52.) The Federal Circuit held that the district court's conditional grant of a new trial, made in response to Cox-Uphoff's untimely March 17, 1989 motion, was of no effect, for "[t]he ten day time period provided in Rule 59 is mandatory and jurisdictional and cannot be extended in the discretion of the district court." (Petitioners' Appendix at A-1.) The Federal Circuit then ordered the district court to reinstate the jury verdict in its entirety. (Petitioners' Appendix at A-1.)[5]

On December 14, 1989, the Federal Circuit denied Cox-Uphoff's petition for rehearing. (Petitioners' Appendix at A-53, A-54.) Subsequently, on January 8, 1990, the Federal Circuit declined Cox-Uphoff's suggestion for rehearing *in banc*. (Petitioners' Appendix at A-56, A-57.)

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[5] As to Cox-Uphoff's cross-appeal regarding the timeliness of its post-judgment motion of March 17, 1989, the Federal Circuit noted that it previously had ruled on two separate occasions that Cox-Uphoff's post-judgment motion for amended findings and for a new trial was untimely, citing its orders of April 3, 1989 and May 23, 1989. (Petitioners' Appendix at A-1.) The court reiterated that the motion was untimely because it was not filed within ten days of the entry of final judgment on February 28, 1989. (Petitioners' Appendix at A-1.)

ARGUMENT

Contrary to Cox-Uphoff's assertions, this case does not raise any issues warranting review by this Court. Although Cox-Uphoff claims that the Federal Circuit has not followed precedent and has not applied the Federal Rules of Civil Procedure in conformity with the decisions of other courts of appeals and this Court, a review of the Federal Circuit's ruling reveals that it is in complete accord with the rules of civil procedure and judicial precedent. The Federal Circuit properly held that Cox-Uphoff's post-judgment motion was untimely because it was not filed within ten days of the final judgment of February 28, 1989.

I. *REVIEW OF THE FEDERAL CIRCUIT'S RULING IS NOT WARRANTED BECAUSE IT IS IN ACCORD WITH THE FEDERAL RULES OF CIVIL PROCEDURE, THE PRIOR DECISIONS OF THIS COURT, AND THE PRIOR DECISIONS OF OTHER COURTS OF APPEALS.*

Cox-Uphoff's petition constitutes a mere attempt to create an issue for review when none in fact exists. Nothing in the record warrants the review of this Court, Cox-Uphoff's meritless arguments to the contrary. Under the applicable Federal Rules of Civil Procedure and the precedents of this Court and others, Cox-Uphoff's post-judgment motion seeking amended findings and conclusions and seeking a new trial was three days too late (excluding weekends and holidays) and, therefore, untimely.

Under the Federal Rules of Civil Procedure, a motion for amended findings or a motion for a new trial must be brought within ten days of entry of judgment. Fed. R. Civ. P. 50(b); 52(b); 59(b), (e). The ten day time period is jurisdictional and mandatory, and may not be extended or enlarged in the discretion of the district court. *Fiester v. Turner*, 783 F.2d 1474, 1476 (9th Cir. 1986); *Scott v. Younger*, 739 F.2d 1464,

1467 (9th Cir. 1984),[6] Fed. R. Civ. P. 6(b). Indeed, this Court expressly has held that ten days after entry of judgment, a district court loses jurisdiction to grant relief under Rules 52 and 59. *Browder v. Director, Ill. Dep't of Corrections*, 434 U.S. 257, 263 n.7 (1978). In *Browder*, the district court entered a final order granting a writ a habeas corpus on October 21, 1975. *Id.* at 260. This Court expressly stated that "the District Court lost jurisdiction 10 days after entry of the October 21 judgment to grant relief under Rule 52(b) or 59 . . . ." *Id.* at 263 n.7.

Under applicable law, therefore, the Federal Circuit correctly ruled that Cox-Uphoff's March 17, 1989 motion was untimely. The district court entered judgment notwithstanding the verdict, the final judgment, on February 28, 1989. The district court's order did not address Cox-Uphoff's motion for a new trial. Any request that Cox-Uphoff had for a ruling on its motion for a new trial had to be timely, *i.e.*, within ten days of the February 28 judgment. Thus, the Federal Circuit correctly ruled that the district court's conditional grant of a new trial on April 25, 1989, which the district court rendered based upon its assumption that it had jurisdiction to so rule, was of no effect because Cox-Uphoff's post-judgment motion was untimely.

In its petition, Cox-Uphoff fails to mention the three day lapse of time rendering its post-judgment motion untimely.[7]

[6] The cases so holding are legion. *See, e.g., Bright v. Bechtel Petroleum, Inc.*, 780 F.2d 766, 772 (9th Cir. 1986); *McConnell v. MEBA Medical and Benefits Plan*, 778 F.2d 521, 526 (9th Cir. 1985); *Roque v. City of Redlands*, 79 F.R.D. 433, 435 (C.D. Cal. 1978) (motion filed fourteen days after entry of judgment untimely); *Pacific Coast Medical Enter. v. Califano*, 440 F. Supp. 296, 308 (C.D. Cal. 1977), *modified and remanded on other grounds*, 633 F.2d 123 (9th Cir. 1980).

[7] Similarly, Cox-Uphoff fails to disclose in its petition that the Federal Circuit ruled on three different occasions that the post-judgment motion was untimely. (Petitioners' Appendix at A-1; Respondents' Appendix at A-1, A-3.) Nor does Cox-Uphoff point out that each time it appealed to the Federal Circuit contending that its motion was timely or that the district court erred in denying its motion for amended findings and conclusions, the Federal Circuit awarded Mentor its attorneys' fees for Cox-Uphoff's frivolous actions. (Petitioners' Appendix at A-1; Respondents' Appendix at A-1, A-3.)

Once the district court failed to rule on Cox-Uphoff's motion for a new trial and entered a final judgment, Cox-Uphoff had ten days in which to move for amended findings and an amended judgment addressing its new trial motion. Ten days after the entry of the February 28, 1989 final judgment, the district court lost jurisdiction to grant Cox-Uphoff's motion for a new trial. *Browder v. Director, Ill. Dep't of Corrections*, 434 U.S. at 263 n.7.

Moreover, from a policy perspective, the Federal Circuit's decision was correct. Adoption of Cox-Uphoff's position would result in the undesirable consequences of confusion, piecemeal appeals, and protracted litigation. *See Osterneck v. Ernst & Whinney*, ___ U.S. ___, ___, 109 S.Ct. 987, 992 (1989) (avoiding piecemeal appellate review of judgments is an "important goal"); *United States v. Hollywood Motor Car Co.*, 458 U.S. 263, 264-65 (1982) (piecemeal appellate review of trial court decisions is "inimical" to the policy of Congress embodied in 28 U.S.C. § 1291 requiring appeals to be taken from final judgments). Litigants must be encouraged to request in a timely manner rulings from a district court on outstanding motions once an otherwise final and appealable judgment is entered.

Cox-Uphoff's reliance on *Montgomery Ward & Co. v. Duncan*, 311 U.S. 243 (1940), is misplaced. In *Duncan* this Court held that a district court's grant of a motion notwithstanding the verdict does not effect an automatic denial of an alternative motion for a new trial, and that if both motions are presented, the district court is required to rule on both motions. 311 U.S. at 249-54. The rule established in *Duncan*, however, is of no import in this case, for in *Duncan* there was no issue regarding the timeliness of either the motion for judgment notwithstanding the verdict or for a new trial. Cox-Uphoff has failed to show the relevance of *Duncan* with respect to the issue of its untimely post-judgment motion.[5]

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[5] *Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317 (1967), and *Nodak Oil Co. v. Mobil Oil Corp.*, 526 F.2d 798 (8th Cir. 1975), are inapposite for the same reasons.

Accordingly, the Federal Court's determination that Cox-Uphoff's post-judgment motion was untimely and that the district court's conditional grant of a new trial was of no effect is fully in accord with the Federal Rules of Civil Procedure and established precedent. Review of this ruling is unwarranted.

II. *REVIEW OF THE DECISION OF THE FEDERAL CIRCUIT IS ALSO UNWARRANTED BECAUSE COX-UPHOFF HAS FAILED TO RAISE ANY ISSUE OF IMPORTANCE.*

Cox-Uphoff further exaggerates the purported importance of this case by incorrectly claiming that even if the district court improperly entered judgment notwithstanding the verdict, a new trial is required because the district court found that the verdict was contrary to the weight of the evidence and that the damage award was excessive. (Petition at 11.)

Cox-Uphoff's argument is without merit. The Federal Circuit considered the merits of Cox-Uphoff's new trial motion, as it was entitled to do. *See Mays v. Pioneer Lumber Co.*, 502 F.2d 106, 110 (4th Cir. 1974), *cert. denied*, 420 U.S. 927 (1975). After reviewing the arguments of the parties, the Federal Circuit determined that substantial evidence in the record supported the jury's findings, and, thus, the district court erred in granting judgment notwithstanding the verdict. (Petitioners' Appendix at A-1.) The appeals court found that substantial record evidence showed that Mentor's patents were valid and that Cox-Uphoff infringed them.

A motion for new trial may be founded on the claim, among others, that the verdict is against the weight of the evidence or that the damages are excessive. *Duncan*, 311 U.S. at 251. The Federal Circuit held that substantial record evidence supported the jury's findings, thereby precluding entry of judgment notwithstanding the verdict; therefore, the Federal Circuit also reviewed the conditional grant of the new trial motion on the merits and found that it was

inappropriate.[9] Accordingly, the district court abused its discretion in conditionally granting Cox-Uphoff a new trial. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1881-83 (Fed. Cir. 1986).

Viewing Cox-Uphoff's argument in this light makes it clear that only Cox-Uphoff would stand to benefit if this Court were to grant the writ. Cox-Uphoff's claims are of importance only to itself. Accordingly, the Court should deny Cox-Uphoff's petition for this reason as well. *See Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 74 (1955) (certiorari should not be granted simply "for the benefit of particular litigants"); *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U.S. 387, 393 (1923) (dismissing writ of certiorari as improvidently granted because the issue was of importantance to only the parties, not to the public).

CONCLUSION

For all of the foregoing reasons, the issue presented does not warrant review and the Petition for Writ of Certiorari should be denied.

Dated: April 27, 1990.

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[9] Mentor previously briefed the merits of Cox-Uphoff's motion for a new trial in the Federal Circuit. (*See, e.g.*, Respondents' Appendix at A 4, A-8.)

APPENDIX

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals for the Federal Circuit

89-1302,-1348

MENTOR CORPORATION, LINDA RADOVAN WILLIAMSON, as executrix of the Estate of CHEDOMIR RADOVAN, HILTON BECKER, M.D., and BEVERLY ANNE BECKER,

Plaintiffs-Appellants,

v.

COX-UPHOFF CORPORATION and COX-UPHOFF INTERNATIONAL,

Defendants-Appellees.

ON MOTION

Before ARCHER, *Circuit Judge.*

ORDER

Cox-Uphoff Corporation, et al., by letter, move to have Mentor Corporation, et al.'s appeals dismissed pursuant to Fed. R. App. P. 4(a) by virtue of the filing by Cox-Uphoff of a post-judgment motion in the district court. By letter response, Mentor apposes the motion and moves for attorney fees of $145.00 incurred in responding to Cox-Uphoff's motion.

On February 28, 1989, the district court entered a final judgment. Mentor, subsequently noticed an appeal. Thirteen business days after entry of judgment, on March 17, Cox-Uphoff filed a Fed. R. Civ. P. 52(b)/59(e) post-judgement motion.

By letter of March 20, Mentor informed Cox-Uphoff that its post-judgment motion was not timely filed with the prescribed 10 day period. It further informed Cox-Uphoff that if it filed a motion to dismiss Mentor's appeals in this court on the ground that they were premature, that it would seek attorney fees. Notwithstanding Mentor's warning letter, Cox-Uphoff moved to dismiss Mentor's appeals.

As set forth in 9 *Moore's Federal Practice*, Par. 204.12(2) 1988:

> Only a timely motion under Rule 50(b), 52(b), 59(b), or 59(e) postpones the running of the time for appeal until entry of the order disposing of the motion. The untimely filing of such a motion has no effect on appeal time.

Thus, as pointed out to Cox-Uphoff, Cox-Uphoff's untimely post-judgment motion has no affect on Mentor's appeal time. Hence, Cox-Uphoff's motion to dismiss is frivolous.

Upon consideration thereof,

IT IS ORDERED THAT:

(1) Cox-Uphoff's motion to dismiss is denied.

(2) Mentor's motion for fees of $145.00 is granted.

4-3-89	/s/ Glen L. Archer, Jr.
Date	Glen L. Archer, Jr. Circuit Judge

cc: Alan M. Anderson, Esq.
Edward J. DaRin, Esq.

09-1302,-1348

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

United States Court of Appeals for the Federal Circuit

89-1302,-1348

MENTOR CORPORATION, LINDA RADOVAN WILLIAMSON, as executrix of the Estate of CHEDOMIR RADOVAN, HILTON BECKER, M.D., and BEVERLY ANNE BECKER,

Plaintiffs-Appellants,

v.

COX-UPHOFF CORPORATION and COX-UPHOFF INTERNATIONAL,

Defendants-Appellees.

ON MOTION

Before ARCHER, *Circuit Judge.*

ORDER

Upon consideration of (1) the motion of Cox-Uphoff for reconsideration of the court's April 3, 1989 order, (2) Mentor Corporation's opposition thereto, (3) Mentor's motion for attorney fees, and (4) Cox-Uphoff's supplemental motion,

IT IS ORDERED THAT:

(1) Cox-Uphoff's motion for reconsideration is denied.

(2) Mentor's motion for attorney fees of $290.00 is granted.

5-23-89 — Date

/s/ Glen L. Archer, Jr.
Glen L. Archer, Jr.
Circuit Judge

cc: Alan M. Anderson, Esq.
Edward J. Darin, Esq.

09-1302,-1348

United States Court Of Appeals for the Federal Circuit

Nos. 89-1302, -1348, -1472

MENTOR CORPORATION; LINDA RADOVAN WILLIAMSON, as executrix of the Estate of CHEDOMIR RADOVAN; HILTON BECKER, M.D.; and BEVERLEY ANNE BECKER,

Plaintiffs-Appellants,

v.

COX-UPHOFF CORPORATION and COX-UPHOFF INTERNATIONAL,

Defendants-Cross-Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA,
HONORABLE JESSE W. CURTIS, SENIOR DISTRICT JUDGE

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* * *

III. *COX-UPHOFF IS NOT ENTITLED TO A NEW TRIAL.*

In its order denying Cox-Uphoff's motion for amended findings on the issues of inequitable conduct and attorneys' fees, the district court belatedly ruled that Cox-Uphoff was entitled to a new trial if its decision granting JNOV was reversed on appeal. (SA-3.) The only reasons given for this ruling were "that the verdict is contrary to the substantial weight of the evidence and that the award of damages is excessive." (*Id.*)

Although it is not clear whether the district court had jurisdiction to grant a new trial to Cox-Uphoff more than ten days after entry of its judgment, *see Browder v. Director, Ill. Dep't of Corrections*, 434 U.S 257 (1978), that decision clearly is reviewable in connection with the instant appeals. *E.g., Mays v. Pioneer Lumber Corp.*, 502 F.2d 106, 110 (4th Cir. 1974), *cert. denied*, 420 U.S. 927 (1975). No doubt exists that the trial court abused its discretion in provisionally granting Cox-Uphoff a new trial. *See, e.g, Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d at 1581-83.

First, the verdict is not contrary to the substantial weight of the evidence. As discussed extensively in Mentor's initial brief and this brief, the jury's findings are supported by substantial evidence. The district court explicitly upheld the jury's finding that the Radovan Patent is valid. The trial court did not disturb the jury's findings of willful infringement on the part of Cox-Uphoff. Cox-Uphoff also has not challenged the jury's conclusion that its RDL X-pand prosthesis infringes the Becker Patent.

Second, the damages awarded are not excessive. Mentor requested $722,000 in damages and the jury awarded $690,000. (App. 65-66, 1956.) That amount can hardly be called excessive. Mentor presented evidence of the demand for the product involved, its production and marketing capacity to make additional sales, and the absence of acceptable noninfringing substitutes. (App. 1478, 1482-83, 1942.) Mentor's damages expert presented unrebutted calculations of Mentor's lost profits. (*See* App. 1951, 1956.) Given this evidence, the jury's damages award clearly was

proper and not excessive. *See, e.g., Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984).

Accordingly, the district court's provisional grant of a new trial must be reversed. The jury's verdict is clearly supported by the evidence. Cox-Uphoff has had its day in court and lost. If the verdict in this action is not upheld in its entirety, then why have jury trials at all?

Conclusion

For the foregoing reasons, and for the reasons stated in its initial brief, Mentor respectfully requests that this Court reverse the district court's orders, findings, and judgment granting JNOV and a new trial in favor of Cox-Uphoff; affirm the district court's denial of Cox-Uphoff's untimely motion on the issues of inequitable conduct and attorneys' fees; award Mentor $2,500.00 in attorneys' fees incurred in responding to Cox-Uphoff's frivolous cross-appeal; and remand this action with instructions to reinstate the judgments, to issue a permanent injunction based upon the jury's verdict and for a decision on Mentor's motions for increased damages, attorneys' fees, and an accounting.

Dated:
August 4, 1989

/s/ Alan M. Anderson

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7814M/7816M

PLAINTIFFS-APPELLANTS' RESPONSE TO DEFENDANTS/
CROSS-APPELLANTS' SUGGESTION FOR REHEARING IN BANC

United States Court Of Appeals
for the Federal Circuit

89-1302, -1348, -1472

MENTOR CORPORATION; LINDA RADOVAN WILLIAMSON, as executrix of the Estate of CHEDOMIR RADOVAN; HILTON BECKER, M.D.; and BEVERLY ANNE BECKER,

Plaintiffs-Appellants,

v.

COX-UPHOFF CORPORATION and COX-UPHOFF INTERNATIONAL,

Defendants/Cross-Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA,
HONORABLE JESSE W. CURTIS, SENIOR DISTRICT JUDGE

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Introduction

This Response to the Defendants/Cross-Appellants' (collectively "Cox-Uphoff") Suggestion for Rehearing In Banc is sumitted on behalf of the Plaintiffs-Appellants (collectively "Mentor") at the request of the court. The panel in this appeal previously, and correctly, denied Cox-Uphoff's Petition for Rehearing. Cox-Uphoff's Suggestion for Rehearing In Banc similarly should be denied. Cox-Uphoff's petition raises no questions of exceptional importance, and in fact presents an argument which Cox-Uphoff's counsel conceded at oral argument was without merit. Cox-Uphoff's Suggestion for Rehearing In Banc should be denied and Mentor should be awarded $1,000 in attorneys' fees and costs for having to respond again to an argument which the panel charitably described as "disingenuous." (Slip op. at 3.)

Argument

I. *THE PANEL CORRECTLY RULED THAT COX-UPHOFF WAS NOT ENTITLED TO A NEW TRIAL.*

In its petition, Cox-Uphoff asserts that the panel incorrectly reversed the district court's conditional grant of a new trial because (1) its motion for a new trial was timely and (2) the jury's verdict, although supported by substantial evidence, was contrary to the weight of the evidence. These positions are inaccurate and without merit.

A. *Cox-Uphoff's Motion to Amend Was Untimely.*

Cox-Uphoff correctly points out that its motion for a new trial was timely filed. However, what Cox-Uphoff has failed to point out previously in this appeal, and continues to fail to point out, is that its motion for amended findings and a ruling on its new trial motion was untimely.

Final judgment was entered on February 28, 1989. That judgment did not grant Cox-Uphoff's motion for a new trial. On March 17, 1989, thirteen days after entry of judgment, Cox-Uphoff moved for amended findings of fact and conclusions of law, including amended findings and

conclusions granting its motion for a new trial.

This motion, however, was intimely because it was not filed within ten days after entry of judgment. *See* Fed. R. Civ. P. 52(c), 59(e). Once ten days have passed from the entry of judgment, a district court has no jurisdiction to grant relief under Rules 52 or 59. *See Browder v. Director, Ill. Dep't of Corrections*, 434 U.S. 257, 263 n.7 (1978). *See also Vera Cruz v. Chesapeake & O. RR.*, 312 F.2d 330, 332 (7th Cir. 1963) (motion for new trial deemed abandoned where ruling on motion not timely requested). Notwithstanding its lack of jurisdiction, however, the district court ruled on April 25, 1989, that assuming it had jurisdiction, it would conditionally grant Cox-Uphoff's motion for a new trial.

Given these facts the panel correctly ruled that the district court's conditional grant of a new trial was of no effect. The district court did not have jurisdiction to consider Cox-Uphoff's untimely request for a ruling on its new trial motion.

B. *Cox-Uphoff Is Not Entitled To A New Trial.*

In any event, this Court can review the merits of the district court's conditional grant of a new trial. *See, e.g., Mays v. Pioneer Lumber Corp.*, 502 F.2d 106, 110 (4th Cir. 1974), *cert. denied*, 420 U.S. 927 (1975). No doubt exists that the district court abused its discretion in conditionally granting Cox-Uphoff a new trial. *See, e.g., Othokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1581-83 (Fed. Cir. 1986).

Cox-Uphoff concedes that the jury's verdict was supported by substantial evidence; yet it also contends that the jury's verdict was contrary to the weight of the evidence. This position is internally inconsistent. Even if one ignores the inconsistency, a brief review of the evidence establishes conclusively that the jury's verdict was correct.[1]

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[1] Cox-Uphoff's description of the district court's findings of fact and conclusions of law as "well reasoned", "carefully crafted", and the result of "months of deliberation" is amazing in light of the fact that Cox-Uphoff submitted the findings and conclusions, at the district court's request, less than one month before the district court adopted them nearly verbatim.

1. *The Becker Patent Is Not Invalid Under § 102(b).*

Cox-Uphoff first argues that the Becker Patent (No. 4,643,733) is invalid under the prior use bar of § 102(b). This argument misrepresents the facts and ignores reality. Indeed, the panel characterized Cox-Uphoff's reliance on this argument on appeal as "disingenuous." (Slip op. at 3.) Furthermore, Cox-Uphoff's counsel conceded at oral argument that this contention was without merit.

As stated previously in Mentor's briefs on the merits, Cox-Uphoff did not list the question of validity of the Becker Patent as one of the issues to be tried in the pretrial order. (*See* App. 90-92.)[2] At trial, Cox-Uphoff did not contend that the Becker Patent was invalid under § 102(b). Cox-Uphoff did not argue for a finding of § 102(b) invalidity in its closing argument, and no question regarding § 102(b) was presented to the jury on the special verdict form. At the close of trial Cox-Uphoff did not move for a directed verdict on this question. (*See* App. 2462-63.) After the jury returned its verdict, Cox-Uphoff did not even move for JNOV or a new trial on the issue of § 102(b) validity. (*See* App. 74-83.) Thus, the district court's grant of JNOV on this issue was a complete surprise to Mentor, and undoubtedly Cox-Uphoff as well.

Furthermore, the facts presented at trial show that Dr. Becker's invention was not in use more than one year before he filed his patent application on April 4, 1983. The "undisputed" facts described by Cox-Uphoff consist of a hearsay footnote in an article published by Dr. Becker in April 1984. In a footnote, the *article's publisher* notes that is was "received for publication December 9, 1982, revised June 27, 1983." (App. 854.) In the text, Dr. Becker states: "Over a period of twenty months, twenty-five cases representing twenty-three patients with a total of thirty-four breasts have been operated on using this implant." (*Id.*)

Dr. Becker testified at trial that his 1984 article was revised up to the date of publication and stated that the twenty month period mentioned in the article is measured

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[2]All citations to "App." are to the Joint Appendix previously filed herein.

backwards from the date of publication, not the date of first submission of the primary revision. (App. 125-27, 2018-19.)

Cox-Uphoff does not dispute that Dr. Becker first conceived of his invention in June or July 1982. Indeed, it would have a hard time doing so given the undisputed evidence at trial, including the patient record of Dr. Becker's first implantation of an early prototype of his invention dated July 30, 1982. (App. 686, 696, 1572-76.) These facts, however, leave Cox-Uphoff in the silly position of arguing that Dr. Becker first used his invention before he even conceived of it. Cox-Uphoff's position means that Dr. Becker first used his invention in April 1981 or November 1981 (twenty months before December 1982 or June 1983), long before Dr. Becker ever thought about his invention. (*See* App. 685, 1570-71, 1600-01.) Thus, Cox-Uphoff's position is frivolous.[3]

2. *Cox-Uphoff Willfully Infringed The Radovan Patent.*

The second argument presented by Cox-Uphoff is that as a matter of law it did not infringe the Radovan Patent (No. 4,217,889) because its product does not have a "substantially stiffer" base. This argument is as meritless as the first.

The jury was properly instructed, without any objection, to consider the specification, prosecution history, and other claims of the Radovan Patent in deciding whether Cox-Uphoff infringed the claims in dispute. (App. 2494-98.) Mentor presented substantial evidence that Cox-Uphoff infringed the Radovan Patent claims in issue.

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[3]Cox-Uphoff asserted this frivolous position in its appeal on the merits. At oral argument, after a lengthy exchange with Judge Mayer, Cox-Uphoff's counsel conceded that the district court's ruling on the issue of § 102(b) invalidity was erroneous. The panel charitably characterized Cox-Uphoff's reliance on the district court's error "disingenuous." (Slip op. at 3.)

Now, Cox-Uphoff not only asserts the same frivolous position, but it fails to advise the court of the fact that the question was not raised below and misrepresents the evidence presented at trial. Accordingly, Mentor requests that Cox-Uphoff be sanctioned and that Cox-Uphoff or its attorneys be ordered to pay Mentor $1,000 in attorneys' fees and costs incurred in having to respond to this frivolous argument again.

For example, Cox-Uphoff's co-founder and vice president admitted that Cox-Uphoff's product had "a shape retaining base reinforced with fabric mesh that is substantially stiffer than the flexible cover of the stretching chamber . . . ." (App. 1690-92.) A Cox-Uphoff engineer similarly admitted literal infringement. (*See* App. 1525-29.) Mentor's patent law expert also testified concerning the proper scope of the claims and Cox-Uphoff's infringement of the Radovan Patent. (App. 1738-48, 1931.)

Perhaps the most damming evidence is the fact that Cox-Uphoff followed the recipe included in the specification of the Radovan Patent in designing its stiff-based tissue expander.[4] The Radovan Patent specification states that the described difference in extensibility between the base and cover can be achieved by the cover being on the order of 0.020 inch thick, while the base is on the order of 0.040 inch thick, with a polyester fabric reinforcement embedded in the base. (App. 297.) Cox-Uphoff's product precisely follows this recipe.[5] (App. 1527, 1541-42, 1748, 1751-52, 2068-69, 2087-88, 2096-97.)

Thus, not only were the jury's findings supported by substantial evidence, they are clearly not contrary to the weight of the evidence. Indeed, a different verdict would have been contrary to the weight of the evidence. Cox-Uphoff is not entitled to a new trial. Its Suggestion for Rehearing In Banc should be denied.

II. *THE PANEL PROPERLY AWARDED ATTORNEYS' FEES TO MENTOR.*

In its *per curiam* reversal of the district court's decision, the panel awarded attorneys' fees to Mentor incurred in

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[4] In developing its stiff-backed tissue expander, Cox-Uphoff was fully aware of the Radovan Patent, yet it never obtained any advice from a patent attorney. (App. 611, 613, 615, 617, 1463, 1657.)

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[5] Throughout the development of its infringing product, Cox-Uphoff referred to the project as being for a tissue expander with "stiff-backing." (App. 611, 615-17.) Following introduction, Cox-Uphoff's marketing brochures described the product as having "stiff-backing." (App. 134, 138, 141, 144, 2085, 2093-94, 2103.)

having to respond to Cox-Uphoff's frivolous cross-appeal. (Slip op. at 3.) Cox-Uphoff, however, mischaracterizes the award at being based upon the conclusion that Cox-Uphoff's motion for a new trial was untimely.

As pointed out previously, Cox-Uphoff's post-judgment motion to amend was filed thirteen days after the entry of judgment, and so was untimely. Cox-Uphoff, however, blissfully ignored that fact and filed a cross-appeal from the district court's denial of its untimely motion. Despite being twice informed by this Court, *see* Orders dated April 3, 1989, and May 23, 1989, that its underlying motion was untimely and hence its cross-appeal frivolous, Cox-Uphoff pressed its cross-appeal, thereby necessitating that Mentor respond. It was for this frivolous behavior, in the face of prior warnings, that Cox-Uphoff was sanctioned and Mentor awarded attorneys' fees. The attorneys' fees award clearly was proper.[6]

Conclusion

For the foregoing reasons, and for the reasons expressed in its prior briefs, Mentor respectfully requests that this Court deny Cox-Uphoff's Suggestion for Rehearing In Banc.

Dated: December 20, 1989

/s/ Alan M. Anderson

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[6]Mentor's present request for $1,000 in attorneys' fees relates solely to having to respond to Cox-Uphoff's argument concerning § 102(b) contained in its Suggestion for Rehearing In Banc. As mentioned previously, not only is that argument meritless, but Cox-Uphoff's counsel so conceded during oral argument. To raise the issue again is not only frivolous, but also completely lacking in candor to the court.